

U.S. Application Serial No. 09/988,291
Attorney Docket No. 47004.000180

REMARKS

Claims 59-61, 63-66, 68-75, 77-80, 82-86, 108, 110-121, 124-127, 130-132 are pending in the application.

By this amendment, the Specification is amended and:

- claims 59, 60, 61, 63-66, 70-75, 77, 78-80, 84-86, 108, 112, 116-119, 124 and 130, 131 are amended;

- claim 132 is added; and

- claims 67, 81, 87, 89-97, 99-107, 109, 122, 123, 128, 129 are cancelled without prejudice or disclaimer to the subject matter set forth therein. Reconsideration and allowance in view of the foregoing amendments and following remarks are respectfully requested.

No new matter has been added by this Amendment. For example, support for added claim 132 may be found on page 5, lines 3-9.

1. The Allowable Subject Matter

In the Office Action, claims 107-109, 112, 116, 123, 128, 129 are objected to as being dependent upon a rejected base claim, but would be allowable if amended to overcome the rejections under 35 U.S.C. 112 and 101 and rewritten in independent form including all of the limitations of the base claim and all intervening claims. The Office Action reflects the prior art does not teach or render obvious respective features in claims 107-109, 112, 116, 128, 129, and 123.¹

¹ The Office Action asserts that referring to claims 107-109, the cited prior art multiple scores are based on purchases by a customer from different merchants. Applicant believes the Examiner intended to indicate that the cited art does not teach such features. Clarification is requested.

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Applicant appreciates such indication of allowable subject matter. The independent claims have been amended to include the features of the objected to claims. However, Applicant has also revised the claims, and in particular the independent claims, to more clearly recite the claimed invention and to reflect the novel aspects of the invention.

That is, the pending independent claims are claims 59, 108, 112, 116, 119, 73 and 130. In the Amendment, Applicant submits that:

Regarding claim 59, the features of claims 67 and 107 have been added into a modified claim 59.

Regarding claim 108, the features of modified claim 59 and claim 67 have been added into claim 108.

Regarding claim 112, the features of modified claim 59 have been added into claim 112.

Regarding claim 119, the features of modified claim 59 and claims 122 and 123 have been added into claim 119.

Regarding claim 73, the features of claims 81 and 109 have been added into a modified claim 73.

Applicant respectfully submits that the changes to the respective independent claims do not effect the basis of allowability reflected in the Office Action.

Applicant notes that claim 130 was not objected to as containing allowable subject matter. However, Applicant submits that independent claim 130, should be allowable as similar in features to claim 112.

Allowance of the application based on the amendments to the claims and the remarks set forth below are respectfully submitted.

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II. The Filed Information Disclosure Statements (IDS)

As noted in Applicant's January 21, 2005 Response, an Information Disclosure Statement (IDS) with PTO-1449 was filed on November 26, 2003. However, no initialed copy appears to have been forwarded to Applicant. Applicant requests an initialed copy of such PTO-1449 showing consideration by the Examiner. Also, Information Disclosure Statements were more recently filed in this application on August 19, 2004 (an electronic filing) and August 30, 2004 (a paper filing).

III. The Objection to the Disclosure

In the Office Action, the disclosure is objected to asserting various informalities. In response, the specification has been amended to address the asserted deficiencies. Applicant submits that the application satisfies all formal requirements.

IV. The 35 U.S.C. §112, first paragraph Rejection

In the Office Action, claims 59-61, 63-75, 77-87, 89-97, 118, and 99-131 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Office Action asserts the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Office Action asserts that claims 59-61, 63-75, 77-87, 89-97, and 99-131 recite the limitation "merchant level", and that such limitation lacks proper written description support in the specification. In response to such assertions, the amended claims do not recite "merchant level".

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The Office Action further asserts that claims 118 and 131 recite the negative limitation "... and not to any particular item purchased at a particular merchant" and that this limitation lacks proper written description support in the specification. This assertion in the Office Action is respectfully traversed. For example, Figs. 2 and 6 clearly provide support for such features relating to merchants and not particular items. However, in order to expedite prosecution, claims 118 and 131 are amended in view of the asserted deficiency.

Applicant respectfully submits that the claims satisfy all requirements of 35 U.S.C. §112.

V. The 35 U.S.C. §112, second paragraph Rejection

In the Office Action, claims 59-61, 63-75, 77-87, 89-97, and 99-131 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action asserts these claims recite the limitation "merchant level", and that Applicants' specification does not provide a definition for this limitation. In response to such assertions, the amended claims do not recite "merchant level".

The Office Action further asserts that the claims fail to point out the invention which the Applicants' have described in their specification, and Applicants' specification discloses that the customer preference is created based on the information stored in the organizational structure (see specification page 2, lines 12-15; page 3, lines 3-6; page 5, lines 10-21; page 6, line 12 - page 7, line 3). The Examiner notes that this feature is not claimed in any of the claims. The Examiner reflects, for example, claim 59 (as presented in the January 21, 2005 Response) recites the steps of receiving customer purchase information, organizing the customer purchase information, creating a customer preference, and forming an offer based on the customer information; but that the step of creating does not explicitly state that the preference is created

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based on the information stored in the organizational structure, as disclosed in the specification. The Examiner recommends that the Applicants amend the claim language to state that the customer preference is created based on the customer information contained in the categories and sub-categories of the organizational structure.

Applicant has carefully reviewed the Examiner's comments and appreciates the Examiner's helpful assistance. The claims have been amended in response to such assertions in the Office Action

Applicant respectfully submits that the claims satisfy all requirements of 35 U.S.C. §112.

VI. The Double Patenting Rejection

In the Office Action, claims 59-61, 63-75, 77-87, 89-97, and 99-131 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of U.S. Patent No. 6,505,168 B1 to Rothman et al. in view of US Patent No. 6,026,370 to Jermyn. As to the amended claims, this rejection is respectfully traversed.

Applicant notes that the Office Action reflects allowable subject matter. Specifically, on page 12, the Office Action asserts that claims 107-109, 112, 116, 123, 128, 129 are objected to as being dependent upon a rejected base claim, but would be allowable if amended to overcome the rejections under 35 U.S.C. 112 and 101 and rewritten in independent form including all of the limitations of the base claim and all intervening claims. Applicant notes that the indication of allowable subject matter does not reflect any contingency vis-à-vis the double patenting rejection and a Terminal Disclaimer.

Further, Applicant submits the claims of the Rothman '168 Patent, either alone or in combination with Jermyn, fail to teach or suggest the claimed invention as recited in the

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independent claims. In particular, such art fails to teach or suggest the recited features relating to the score, percentage value and/or count value.

Withdrawal of the double parenting rejection is respectfully requested.

VII. The 35 U.S.C. §101 Rejection

On page 8, the Office Action asserts that Claims 59-61, 63-72, 87, 89, 90-96, 107-108, 110, and 112-131 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Office Action asserts that in the present application, claims 59-61, 63-72, 87, 89, 90-96, 107-108, 110, and 112-131 are not within the technological arts because the claims do not utilize technology in a non-trivial manner in order to perform the steps of receiving, organizing, creating, and forming. In order to overcome this rejection, the Examiner recommends that the Applicants amend the claim language to incorporate non-trivial use of technology in the body of the independent claims.

In response to the assertions in the Office Action, Applicant has amended the claims to include the non-trivial use of technology in the body of the independent claims.

Further, on page 11, the Office Action asserts that claims 59-61, 63-72, 107, 108, 110, and 112-131 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Office Action reflects that 35 U.S.C. 101 requires that in order for an invention to be patentable it must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). The Office Action asserts that Applicants' claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. 101. The Office Action explains that the independent claims 59 and 130 begin by discussing a system for storing and manipulating information but then include the specific steps of a method. The Office Action

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asserts that a claim of this type is precluded by the express language of 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.

The Office Action proposes in order to overcome this rejection, the Examiner recommends that the Applicants limit the independent claims to one statutory class of invention. The claims of the application have been amended in response to the asserted deficiencies.

It is respectfully submitted that the claims satisfy all requirements of 35 U.S.C. §101.

VIII. The Claims Define Patentable Subject Matter

A. The Rejection Based on Eldering and Chakrabarti

In the Office Action, claims 59, 61, 63-66, 71-73, 75, 77-80, 85-87, 95-97, 105, 106, 110, 111, 117, 119-121 and 130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US 6,216,129 B1) in view Chakrabarti et al. (US 6,334,131 B2). This rejection is respectfully traversed.

The Office Action asserts that referring to claims 59, 73, 87, 97, and 130, Eldering teaches a method and system comprising: receiving merchant-level customer purchase information (column 1, lines 25-50; column 6, lines 33-43; column 7, lines 55-67); organizing the merchant level customer purchase information within a predetermined organizational structure, wherein the predetermined organizational structure comprises a plurality categories arranged in a hierarchy (column 7, lines 22-34; column 8, lines 20-30); creating a customer preference based at least in part on the merchant level customer purchase information (Abstract; column 1, lines 51-58); forming a merchant level offer for a customer based on the merchant level customer purchase information (column 1, lines 51-58; column 3, lines 13-28; column 4, lines 21-25). The Office Action further asserts that Eldering does not teach that each category comprises a plurality of sub-categories or that the hierarchy has a top-down taxonomy, but that

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however, Chakrabarti teaches a method and system for cataloging user information in a hierarchical database structure comprising a plurality of sub-categories and having a top-down taxonomy (column 1, lines 8-42; Figures 2-4).

The Office Action concludes that therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Chakrabarti into the invention of Eldering; and that one of ordinary skill in the art would have been motivated to do so in order to logically organize and further refine the classification of Eldering by using the sub-categories and top-down taxonomy of Chakrabarti.

The features of claim 59 are set forth in the listing of claims above. Claim 59 is directed to a method for making targeted offers, the method implemented in a computer system for storing and manipulating customer purchase information received from a plurality of sources. In conjunction with various other features, claim 59 recites the feature of wherein the step of generating a customer score, includes generating multiple customer scores for a single customer, the multiple customer scores for the single customer each being respectively associated with a different merchant. The applied art fails to teach or suggest such features.

The Office Action appears to assert that it would have been obvious to the one of ordinary skill to modify Eldering based on asserted teachings of Chakrabarti relating to cataloging user information in a hierarchical database structure comprising a plurality of sub-categories and having a top-down taxonomy. However, even if it were obvious to so modify Chakrabarti, which Applicant does not admit is obvious, such modified Chakrabarti would still fail to teach the specifics of claim 59.

Further, it is submitted that the other independent claims recite other particulars that are not taught or suggested by the applied art, i.e., as articulated in the indication of allowable

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subject matter in the Office Action (see page 12 of the Office Action). Applicant submits that the dependent claims define patentable subject matter for the reasons set forth above with regard to the independent claims, from which they variously depend, as well as the additional features set forth in each of the dependent claims.

B. The Rejection Based on Eldering, Chakrabarti and Ellis

The Office Action asserts that claims 67, 81, 122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US 6,216,129 B1) in view Chakrabarti et al. (US 6,334,131 B2) and further in view of Ellis et al. (US PUB 2003/0020744 A1).

The Office Action asserts referring to claims 67, 81, and 122, the cited prior art does not teach generating a customer score based on customer accounts prior to creating a customer preference, but that however, Ellis teaches a method and system for targeted advertisement (Abstract) wherein a user's history is used to generate a value (i.e. score) prior to creating a preference (paragraphs [0107] and [0126]), and that therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Ellis into the cited prior art.

However, even if it were obvious to so modify Chakrabarti with the alleged teachings of Ellis, which Applicant does not admit is obvious, such modified Chakrabarti would still fail to cure the deficiencies as noted above.

C. The Further 35 U.S.C. §103 Rejections

The Office Action asserts that claims 60, 68, 69, 74, 82, and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US 6,216,129 B1) in view Chakrabarti et al. (US 6,334,131 B2) in view of Official Notice. The Office Action further asserts that claims 70, 84, 89-94, and 99-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering

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(US 6,216,129 B1) in view Chakrabarti et al. (US 6,334,131 B2) and further in view of Guheen et al. (US PUB 2004/0107125 A1).

The Office Action proposes to modify the Eldering/Chakrabarti combination with respect to (1) the offer is extended via e-mail or web page, (2) updating the organizational structure when the information reaches a threshold level, and (3) matching selected words or characters with words or characters contained within the customer purchase information.

Applicant does not admit that such modifications to the Eldering and Chakrabarti combination would have been obvious. Rather, Applicant submits that even if it were obvious to somehow modify Eldering as proposed in the Office Action, such modified Eldering would still fail to teach or suggest the particulars of claim 59 and the other independent claims.

Withdrawal of the various 35 U.S.C. §103 rejections vis-à-vis the amended claims is respectfully requested.

IV. Conclusion

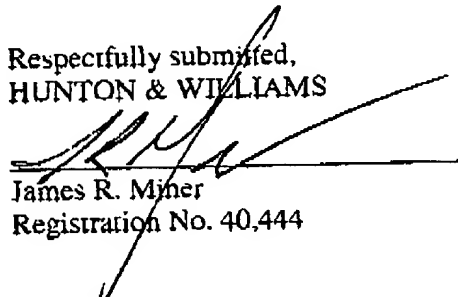
Applicant respectfully submits that this application is in condition for allowance, and reconsideration and allowance of the application is respectfully requested. If the Examiner believes that prosecution might be advanced by discussing the application with Applicant's counsel, in person or over the telephone, we would welcome the opportunity to do so.

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It is believed that no fees are due with this response in excess of those otherwise provided for. However, in the event any other fees are due, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
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